

an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface between braces ( { } ) the page and line or paragraph after each limitation where the limitation is described in the specification as filed. If there is a drawing or amino acid or nucleotide material sequence, and at least one limitation is illustrated in a drawing or amino acid or nucleotide material sequence, the “claims support and drawing analysis section” in the appendix shall also contain in boldface between the same braces ( { } ) where each limitation is shown in the drawings or sequence.

(s) *Means or step plus function analysis section.* For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section) having a limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112, for each such limitation, the “means or step plus function analysis section” in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface between braces ( { } ) the page and line of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function.

(t) *Evidence section.* The “evidence section” shall contain only papers which have been entered by the examiner. The evidence section shall include:

(1) *Contents.* A table of contents.

(2)–(4) [Reserved]

(5) *Affidavits and declarations.* Affidavits and declarations, if any, and attachments to declarations, before the examiner and which are relied upon by appellant in the appeal. An affidavit or declaration otherwise mentioned in the appeal brief which does not appear in the evidence section will not be considered.

(6) *Other evidence filed prior to the notice of appeal.* Other evidence, if any, before the examiner and filed prior to the date of the notice of appeal and relied upon by appellant in the appeal. Other evidence filed before the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.

(7) *Other evidence filed after the notice of appeal.* Other evidence relied upon by the appellant in the appeal and admitted into the file pursuant to §41.33(d) of this subpart. Other evidence filed after the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.

(u) *Related cases section.* The “related cases section” shall consist of copies of orders and

opinions required to be cited pursuant to paragraph (g) of this section.

(v) *Appeal brief format requirements.* An appeal brief shall comply with §1.52 of this title and the following additional requirements:

(1) *Page and line numbering.* The pages of the appeal brief, including all sections in the appendix, shall be consecutively numbered using Arabic numerals beginning with the first page of the appeal brief, which shall be numbered page 1. If the appellant chooses to number the lines, line numbering may be within the left margin.

(2) *Double spacing.* Double spacing shall be used except in headings, tables of contents, tables of authorities, signature blocks, and certificates of service. Block quotations must be indented and can be one and one half or double spaced.

(3) [Reserved]

(4) *Font.* The font size shall be 14 point, including the font for block quotations and footnotes.

(5) *Length of appeal brief.* An appeal brief may not exceed 30 pages, excluding any statement of the real party in interest, statement of related cases, jurisdictional statement, table of contents, table of authorities, status of amendments, signature block, and appendix. An appeal brief may not incorporate another paper by reference. A request to exceed the page limit shall be made by petition under §41.3 filed at least ten calendar days prior to the date the appeal brief is due.

(6) *Signature block.* The signature block must identify the appellant or appellant’s representative, as appropriate, and a registration number, a correspondence address, a telephone number, a fax number and an e-mail address.

#### §41.39 Examiner’s answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner’s answer may include a new ground of rejection.

(b) If an examiner’s answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner’s answer exercise one of the following

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two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under §1.111 of this title with or without amendment or submission of affidavits (§§1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of §1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in §41.41. Such a reply brief must address each new ground of rejection as set forth in §41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in §41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to reply for patent applications and §1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

EFFECTIVE DATE NOTE: At 73 FR 32975, June 10, 2008, §41.39 was revised, effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this action was delayed indefinitely.

For the convenience of the user, the revised text is set forth as follows:

### §41.39 Examiner's answer.

(a) *Answer.* If the examiner determines that the appeal should go forward, then

within such time and manner as may be established by the Director the examiner shall enter an examiner's answer responding to the appeal brief.

(b) *No new ground of rejection.* An examiner's answer shall not include a new ground of rejection.

### §41.41 Reply brief.

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See §1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and §41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to reply for patent applications and §1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

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For the convenience of the user, the revised text is set forth as follows:

### §41.41 Reply brief.

(a) *Reply brief authorized.* An appellant may file a single reply brief responding to the points made in the examiner's answer.

(b) *Time for filing reply brief.* If the appellant elects to file a reply brief, the reply brief must be filed within two months of the date of the mailing of the examiner's answer.

(c) *Extension of time to file reply brief.* A request for an extension of time to file a reply brief shall be presented as a petition under §41.3 of this part.

(d) *Content of reply brief.* Except as otherwise set out in this section, the form and content of a reply brief are governed by the